

REMARKS/ARGUMENTS

Applicants have carefully considered the Office Action of July 14, 2003 and set forth detailed responses herein. Minor changes have been made to the specification, in particular to the Abstract portion of the specification, in accordance with the Examiner's suggestion.

Claims of group II (Claims 5-10) are elected for prosecution. Claims 1-4 and claims 11-17 are withdrawn and remain pending until such time as Applicants' file additional divisional applications.

The Examiner has requested an update regarding the status of parent applications listed under "Cross-Reference to Related Applications". U.S. patent application serial number 09/499,058, is currently pending and is being examined by Examiner Bangachon. As stated in the aforementioned "Cross-Reference to Related Applications", Application Ser No. 09/499,058 is a Continued Prosecution Application based upon U.S. patent application serial number 08/859,904, therefore application serial number 08/859,904 is abandoned.

A substitute oath, executed by two of the inventors, is enclosed herein. Applicants' representatives are currently attempting to obtain execution of same by Lawrence Hecox.

Claims 5-10 have been amended.

Claims 18-26 are newly added apparatus claims, support for which may be found on pages 28-30 in the instant application.

No new matter is added.

REJECTIONS UNDER 35 U.S.C. 112, second paragraph

Claims 5-10 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants have amended claims 6-10 to recite "call receiving pager apparatus" in the preamble, thus better clarifying the claimed subject matter. Additionally, claim 5 has been amended to recite "call receiving pager apparatus", in accordance with the Examiner's suggestion. Thus, the pending rejections under 35 U.S.C. 112, second

Appl. No. 09/638,587

Attorney Docket No. 56838-010200

paragraph have been overcome, and accordingly Applicants respectfully request that the Examiner withdraw these rejections.

REJECTIONS UNDER 35 U.S.C. § 102(b) and 103(a)

Claims 5-10 are rejected under 35 U.S.C. 102(b) as being anticipated by or in the alternative, under 35 U.S.C. 103(a) as obvious over US 5,117,449 (Metroka et al.). Applicants respectfully traversed these rejections.

The sole cited reference (Metroka et al.) cited in the Examiner's rejections is directed to paging and cellular radiotelephone functions which are combined in a single device by sharing most circuitry. The apparatus can receive paging signals simultaneously with radiotelephone signals because of dual receivers and includes a memory for storing telephone numbers. Nowhere is it disclosed, taught or suggested that the apparatus of Metroka et al. that the transmission of at least one of a voice message, a text message, or data message to a telephone number preprogrammed into the apparatus wherein the transmitted message asks a call receiver at said preprogrammed telephone number to initiate a call to the apparatus, as claimed in independent claim 5. This is the means by which two-way communication is established by the apparatus of the present invention. In opposition to the teachings and apparatus of Metroka et al., wherein a user of the combination pager and radiotelephone can utilize the apparatus to simply call outside numbers in the traditional sense, the claims of the present invention define an apparatus that requires a transmission of a request to an outside caller to call/call once more the user (typically referred to as the subscriber in the specification of the instant application) of the call receiving pager apparatus of the present invention in order for the two parties to establish communication.

NOT
CLAIMED

Furthermore, the combined radiotelephone and paging system and apparatus of Metroka et al. does not prevent initiation of direct two-way communication by the holder/subscriber of the apparatus. As the Federal Circuit has held and as stated in the M.P.E.P. at 2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention

NOT
CLAIMED

Appl. No. 09/638,587

Attorney Docket No. 56838-010200

must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Since the positively recited element of transmitting at least one of a voice message, a text message, or data message to a telephone number preprogrammed into the call receiving pager apparatus of Claim 5 and all claims dependent therefrom, wherein the message asks a call receiver at the preprogrammed telephone number to initiate a call to said call receiving pager apparatus in order to establish direct two-way communication, is not found in Metroka et al., Metroka et al. is not an anticipating reference. Therefore, Applicants respectfully request that the Examiner withdraw the pending 35 U.S.C. 102(b) rejections.

NOT CLAIMED { The Examiner has also rejected, in the alternative, claims 5-10 under 35 U.S.C. 103(a), stating that it would be obvious that a user of a radiotelephone, if not reached by a caller, would return the call via "a message asking a call receiver at a preprogrammed telephone number to initiate a call to said call receiving pager apparatus". This is simply not the case. In fact, this is one of many aspects that delineates the presently claimed call receiving pager apparatus from the prior art. Namely and as discussed in the specification, this requested callback by the subscriber/user of the present invention is needed in order to establish direct two-way communication between an "outside" caller and the user of the present invention.

NOT CLAIMED { Additionally, Applicants respectfully point out that the Examiner appears to have mistakenly attributed the requested call-back message to be from a caller to the call receiving pager apparatus (Paper No. 4, page 8). This is not what is claimed, but rather it is the user/subscriber of the call receiving pager apparatus that must transmit the request, via call receiving pager apparatus, to the entity calling the call receiving pager apparatus. In response to receiving this transmission, the caller must once again call the user/subscriber of the call receiving pager apparatus in order to establish direct communication. This is not equivalent to simply calling someone back and having them pick up the phone, after which direct communication will take place. Instead, the caller would receive the call back request and then must call the user/subscriber of the call receiving pager apparatus to initiate direct two-way communication, something the user/subscriber of the call receiving pager apparatus cannot do when transmitting the request.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, **not in applicant's disclosure**. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (emphasis added). Furthermore, the use of the guidance of the claimed invention in an obviousness determination is hindsight. It has been specifically proscribed by the Federal Circuit in the determination of the existence or nonexistence of a prima facie case of obviousness. Interconnect Planning Co. v. Feil, 774 F.2d 1132, 227 U.S.P.Q. 543 (Fed. Cir. 1985).

There is **no** suggestion, teaching or motivation in Metroka et al. for the claimed call receiving pager apparatus of the pending claims, particularly relating to the transmitting of at least one of a voice message, a text message, or data message to a telephone number preprogrammed into a call receiving pager apparatus, wherein the message asks a call receiver at a preprogrammed telephone number to initiate a call to the call receiving pager apparatus, as presently claimed.

Therefore, Applicants respectfully request that the Examiner withdraw all 35 U.S.C. 103(a) rejections.

New claims 18-26 are newly added and further define the present invention. Support for various components and aspects recited in new claims 18-26 may be found on pages 28-30 of the specification. In addition to patentable independent claim 5, as discussed above, the newly added set of claims recited various aspects, such as a dedicated switch, maintenance of a directory inbound dialing number, a mobile identification number and a verification encoding signal, among other recitations. Metroka et al. does not disclose these and other elements recited in claims 18-26.

In view of the foregoing, it is respectfully submitted that the Claims in the application are in condition for allowance. Allowance of the Claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call Applicants' undersigned representatives, attention

Appl. No. 09/638,587

Attorney Docket No. 56838-010200

Claude Nassif, Ph.D. at (310) 586-7828 to discuss the steps necessary for placing the application in condition for allowance.

No fee is believed due with this response. However, if Applicants are mistaken, the Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 50-2638. Please ensure that the Attorney Docket Number is referred to when charging any payments or credits for this case.

Respectfully submitted,

GREENBERG TRAURIG, LLP

Date: February 23, 2004

By: 

Claude Nassif, Ph.D.

Reg. No. 52,061

Tel.: (310) 586-7828

Greenberg Traurig, LLP
2450 Colorado Avenue, Suite 400
Santa Monica, California 90404
Telephone: 310-586-7700
Facsimile: 310-586-7800